

REMARKS**1. STATUS OF THE CLAIMS**

Claims 1-9 and 16-24 were pending in the application as of the Office Action mailed November 19, 2003. New claim 25 is added by amendment herein. Therefore, claims 1-9 and 16-25 are currently pending.

The Examiner asserts that claims 19-20 and 22 are allegedly, "drawn to sequences other than the elected SEQ ID NO:3, and thus drawn to non-elected inventions". For this reason, the Examiner withdrew claims 19-20 and 22 from consideration. Applicants respectfully traverse the present assertion that claims 19-20 and 22 are allegedly drawn to sequences other than the elected SEQ ID NO:3. Careful review of each sequence set forth in claims 19-20 and 22 demonstrates that these sequences are species of generic claim 16. Should generic claim 16 be found allowable, Applicants respectfully request that claims 19-20 and 22 be entered into the application for examination.

2. Claim Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 23 and 24 under 35 U.S.C. § 101 alleging that claims 23 and 24 are drawn to non-statutory subject matter. The present rejection is respectfully traversed; however, in view of the amendments made herein, the rejection is believed to be moot.

3. Claim Rejections under 35 U.S.C. § 102(b)

Claims 1-9, 16-17, 21, and 23-24 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Calvert et al.

(J Gen. Virol. (1995) 76:1271-1278). The present rejection is respectfully traversed.

The Court of Appeals for the Federal Circuit has repeatedly recognized that anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference and that the prior art reference be enabling, thus placing allegedly disclosed matter in the possession of the public. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1 USPQ 2d 1241 (Federal Circuit 1986), certiorari denied, 107 S. Ct. 2470, 96 L. Ed. 2d 382. The proper inquiry under 35 U.S.C. § 102 is whether a prior publication bears within its four corners adequate directions for practice of the patent invention. Illinois Tool Works, Inc. v. Foster Grant Co., Inc., 395 F.Supp. 234 (D.C. Ill. 1974), affirmed 547 F.2d 1300, 192 USPQ 365, certiorari denied, 97 S.Ct. 2631, 53 L.Ed. 2d 243.

a. Claims 1-7

Claim 1 is directed to an isolated nucleic acid molecule comprising a promoter nucleotide sequence that initiates transcription of an operably linked heterologous nucleic acid sequence in a plant cell wherein said promoter nucleotide sequence has at least 95% identity to 18 sequential nucleotides of the cassava vein mosaic virus (CsVMV) promoter shown in SEQ ID NO 3 (pA).

The term "isolated nucleic acid molecule" is defined in the specification to mean, "subject nucleic acids that do not contain the naturally occurring adjacent counterpart sequences, such as the CsVMV promoter in the context of the CsVMV genome, but rather are manipulated to be separated from other portions of the CsVMV genome, or to be recombined with heterologous sequences" (see, e.g., page 14 line 27-page 15, line 2).

Calvert et al. does not disclose nucleic acids that contain the CsVMV promoter "separated from other portions of the CsVMV

genome". By the Examiner's own admission, Calvert et al. "clearly discloses that the genomic DNA of CVMV virus is cloned into a plasmid vector" (emphasis added). Nowhere does Calvert et al. disclose the isolated CsVMV promoter. Therefore, claim 1, and dependent claims, which are directed to an "isolated nucleic acid molecule" as defined in view of the specification, cannot be anticipated by Calvert because Calvert does not teach each and every element of the present claims.

c. Claims 8-9

Claims 8 and 9, as amended, are directed to a vector comprising a promoter nucleotide sequence that is capable of initiating transcription of an operably linked heterologous nucleic acid sequence in a plant cell wherein said promoter nucleotide sequence has at least 95% identity to 18 sequential nucleotides of the cassava vein mosaic virus (CsVMV) promoter shown in SEQ ID NO 3 (pA) and wherein said promoter nucleotide sequence is operatively linked to the heterologous nucleic acid sequence.

Nowhere does Calvert et al. teach a vector comprising the claimed promoter nucleotide sequence operatively linked to the claimed heterologous nucleic acid sequence. Thus, Calvert et al., cannot anticipate the present claims because Calvert et al., does not teach each and every element of the claimed invention.

d. Claims 16-17 and 21

Claims 16-17 and 21 are directed to an isolated nucleic acid molecule, comprising: a CsVMV promoter nucleotide sequence that initiates transcription of an operably linked heterologous nucleic acid sequence in a plant cell.

Calvert et al. does not disclose an isolated nucleic acid molecule that contains the CsVMV promoter "separated from other

portions of the CsVMV genome", as discussed above for claims 1-7. Therefore, claim 16, and dependent claims, which are directed to an "isolated nucleic acid molecule" as defined in view of the specification, cannot be anticipated by Calvert because Calvert does not teach each and every element of the present claims.

e. Claims 23-24

Claims 23-24, as amended, are directed to an isolated polynucleotide comprising SEQ ID NO:3, or a fragment thereof having promoter activity.

Nowhere does Calvert et al. teach an isolated polynucleotide comprising SEQ ID NO:3, or a fragment thereof, as discussed above for claims 1-7. Thus, Calvert et al., cannot anticipate the present claims because Calvert et al., does not teach each and every element of the claimed invention.

4. Claim Objections

The Examiner has objected to claim 18 as being dependent upon a rejected base claim, wherein claim 18 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claim 18 as suggested by the Examiner and respectfully request that claim 18 be placed in condition for allowance.

The Examiner has objected to claims 2, 7, and 21 allegedly "because they contain subject matter drawn to unelected inventions". The sequence of SEQ ID NO:3 (pA) was elected with traverse in a Response to Restriction Requirement mailed July 27, 2001. The Applicants respectfully submit that claims 2 and 7 read on SEQ ID NO:3 and other sequences each of which is a species of the sequence claimed in generic claim 1. Thus, in the event that generic claim 1 is found to be allowable, Applicants respectfully request that the objection to claims 2 and 7 be withdrawn.

Regarding claim 21, claim 21 is a species of generic claim 16. In the event that generic claim 16 is found to be allowable, Applicants respectfully request that the objection to claim 21 be withdrawn.

CONCLUSION

Claims 1-9 and 16-25 are currently pending. The Applicants respectfully traverse all claim rejections. The Applicants respectfully submit that all pending claims are in condition for allowance and request that the Examiner allow all pending claims.

No new matter is added by way of the present Response.

The Examiner is requested to contact the representative for the Applicants, to discuss any questions or for clarification.

If there are any further fees associated with this response, the Director is authorized to charge our Deposit Account No. 19-0962.

Respectfully submitted,

Feb. 19, 2004

Date

Michael J. McCarthy
Michael J. McCarthy, Reg. No. 46,910

THE SCRIPPS RESEARCH INSTITUTE
Office of Patent Counsel
10550 North Torrey Pines Road
Mail Drop TPC-8
La Jolla, California 92037
(858) 784-2937